

Application No.: 09/718,685
Attorney Docket No. 09367.0052-02000

REMARKS

Applicants gratefully acknowledge the Examiner's withdrawal of the rejections under 35 U.S.C. § 112, first paragraph. Applicants respectfully request reconsideration of the rejection set forth in the Final Office Action mailed January 24, 2005.

Claims 40-43 and 51 are pending and rejected. Applicants have amended claim 40 herein. The amendment to claim 40 finds support, for example, at page 24, lines 17-27 of the specification and does not add new matter.

Applicants have amended claim 40 to better define one embodiment of the invention, notwithstanding the Applicants' belief that the unamended claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals. None of the amendments to the claims is related to the statutory requirements of patentability unless expressly stated so herein.

The Office rejected claims 40-43 and 51 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. (Office Action at pages 2-3.) In particular, the Office contends that the phrase "fingerprints associated with application of a manipulation to cell lines in a database" is vague and indefinite. (Office Action at page 2.) The Office suggested that Applicants address this alleged vagueness by particularly pointing out what defines and/or formulates the association that is between the "fingerprints" and the "application of a manipulation to cell lines in a database." (Office Action at page 3.)

Application No.: 09/718,685
Attorney Docket No. 09367.0052-02000

In response, Applicants note that claim 40 as amended, and claims 41-43 and 51 as they depend from amended claim 40, recite ". . . code for producing a statistical profile of said manipulated cells by statistically comparing said fingerprint against fingerprints in a database, wherein said fingerprints in said database are associated with produced by application of [(a)] at least one different manipulation to one or more different cell lines of different cell types in a database . . ." Applicants submit that this language defines the association between the fingerprints in the database and the manipulation(s) of cell lines from which the database fingerprints are derived. This language is neither vague nor indefinite. Applicants respectfully request that this rejection be withdrawn.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 40-43 and 51 in condition for allowance. Applicants submit that the proposed amendment of claim 40 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Lauren L. Stevens
Reg. No. 36,691
Customer No. 22,852